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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
NGUYEN, TOAN D	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/840,212	EDSALL ET AL.	
	Examiner	Art Unit	
	Toan D. Nguyen	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 May 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/21/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

On page 9 line 10, it is suggested to change "VLAN #2 350" to --- VLAN #1 350 ---.

On page 12 line 1, it is suggested to change "thy" to --- they ---.

Appropriate correction is required.

Claim Objections

2. Claims 5, 7-38, 40 and 41 are objected to because of the following informalities:

In claim 5 line 6, it is suggested to change "a shared network" to --- the shared network ---.

In claim 7 line 11, it is suggested to change "an isolated port" to --- an isolated port of the one or more isolated ports ---. Similar problems exist in claim 11 line 9; claim 18 line 11; claim 22 line 9; claim 29 line 12; claim 33 line 9; claim 40 line 11 and line 17; and claim 41 line 11 and line 17.

In claim 7 line 12, it is suggested to change "another isolated port" to --- another isolated port of the one or more isolated ports ---. Similar problems exist in claim 11 line 10; claim 18 line 12; claim 22 line 10; claim 29 line 13; claim 33 line 10; claim 40 line 13 and line 19; and claim 41 line 13 and line19.

In claim 7 line 13 and line 16, it is suggested to change "a community port" to --- a community port of the one or more community ports ---. Similar problems exist in

claim 12 line 9; claim 18 line 13 and line 16; claim 23 line 9; claim 29 line 14 and line 17; and claim 34 line 9.

In claim 7 line 14, it is suggested to change "a one or more promiscuous ports" to --- the one or more promiscuous ports ---. Similar problems exist in claim 18 line 14; and claim 29 line 15.

In claim 7 line 16, it is suggested to change "a promiscuous port" to --- a promiscuous port of the one or more promiscuous ports ---. Similar problems exist in claim 12 line 9; claim 13 line 9; claim 15 line 9; claim 18 line 16; claim 23 line 10; claim 24 line 10; claim 26 line 10; claim 29 line 18; claim 34 line 10; and claim 35 line 10.

In claim 7 lines 17-18, it is suggested to change "a one or more isolated ports" to --- the one or more isolated ports ---. Similar problems exist in claim 18 line 18; claim 29 line 19; and claim 35 line 9.

In claim 8 line 7, it is suggested to change "separate packet traffic" to --- separate the packet traffic ---. Similar problems exist in claim 10 line 8; claim 19 line 7; claim 21 line 8; claim 30 line 7; and claim 32 line 8.

In claim 9 line 3, it is suggested to change "a community VLAN" to --- the community VLAN ---. Similar problem exist in claim 20 line 3.

In claim 12 line 10, it is suggested to change "other community port" to --- other community port of the one or more community ports ---. Similar problems exist in claim 18 line 17; and claim 23 line 10.

In claim 13 line 8, it is suggested to change "a one or more other ports" to --- the one or more other ports ---. Similar problems exist in claim 15 line 8; claim 24 line 9; and claim 26 line 9.

In claim 14 line 1, it is suggested to change "A router" to --- The router ---. Similar problems exist in claim 16 line 1; claim 17 line 1; claim 25 line 1; claim 27 line 1; claim 28 line 1; claim 30 line 1; claim 31 line 1; claim 32 line 1; claim 36 line 1; claim 37 line 1; and claim 38 line 1.

In claim 29 line 19, it is suggested to change "transfer packets" to --- transfer the packets ---.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claim 9, 20 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9 line 3, it is unclear as to what is meant by "a VLAN for a designated set of community ports". The scope of the claim is, therefore, unascertainable. Similar problems exist in claim 20 line 3; and claim 31 line 3.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 46 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 46 that recite nothing but the physical

characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material. "The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." Corning v. Burden, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." Shell Development Co. v. Watson, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C.

1957), aff'd, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

A manufacture is also defined as the residual class of product. 1 Chisum, § 1.02[3] (citing W. Robinson, The Law of Patents for Useful Inventions 270 (1890)). A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,741,592. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claims 1-46 merely broaden the scope of the patented claims by not claiming some claim elements (i.e., establishing at least one promiscuous port, said promiscuous port receiving packets from an external circuit connected to said promiscuous port). The application's claims are nearly identical in every other respect to the patented claims. Therefore, the application's claims are simply broader versions of the patented claims. It is Examiner's position that broadening the patented claims by claiming some claim elements (i.e., establishing at least one promiscuous port, said promiscuous port receiving packets from an external circuit connected to said promiscuous port) of the patented claims would have been obvious to one of ordinary skill in the art in view of the patented claims. It is important to note that the instant application is a combination of the application, which yielded the patent (USP 6,741,592) used herein as the basis for the obvious-type double-patenting rejection. The applicant is attempting to broaden the parent application's claims by eliminating some of the claim elements in the continuation at issue here. If allowed, the application at bar would unjustly extend Applicant patent protection beyond the statutory period, at the same time, granting broader protection to the applicant.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan D. Nguyen whose telephone number is 571-272-3153. The examiner can normally be reached on M-F (7:00AM-4:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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